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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,429

01/05/2006

Guy Schott

0579-1091

6008

466

7590

09/04/2008

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EXAMINER

REYNOLDS, STEVEN ALAN

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

09/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/535,429	<b>Applicant(s)</b> SCHOTT ET AL.	
	<b>Examiner</b> Steven Reynolds	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/19/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 2 is objected to because of the following informalities: In claim 2, "it is made in one piece" should read "the package is made in one piece". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 is not a proper dependent claim as it appears to claim the same features as independent claim 1 but uses different terminology (i.e. the "rectangular panel" is the same as the "external lateral panel" of claim 1).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-3, 5-11, 15, 16 and 19-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Lamare (EP 0693428) in view of DeNola (US 5,529,187). Lamare discloses packaging (See Figs 3, 5B) for protecting and locating a circular contour object such as an eyeglass lens, the packaging including a bottom panel (7); two box-sections each including an external lateral panel (13) and an internal lateral panel (11) that includes an opening (15) for at least partial insertion of the object, each box-section being attached by an articulation (fold line 17) to the bottom panel along a respective one of two opposite edges (at fold lines 17 in Fig. 3), each box-section being adapted to assume a folded down position (See Fig. 3) in which the external lateral panel is in line with the bottom panel and a raised position (See Fig. 2) in which the external lateral panel upstands relative to the bottom panel; two flaps (panels 14) each attached by an articulation (fold lines 24) to the bottom panel along a respective one of two opposite edges (at fold lines 24 in Fig. 3) adjacent the box-sections, each flap being adapted to assume a folded down position in which it is in line with the bottom panel and a raised position in which the flap upstands relative to the bottom panel, against the longitudinal ends of the box-sections; and means for maintaining the box-sections and the flaps in

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the raised position (gussets 27); characterized in that, for each box-section, said external lateral panel has a first end connected by an articulation (17) to the bottom panel, a second end connected by an articulation (fold line between 13 and 18) to a first end of an intermediate panel (18), the latter also including a second end connected by an articulation (fold line 20) to a first end of said internal lateral panel, the latter also including a second end connected by an articulation (fold line between 11 and 19) to the bottom panel along the articulation between the first end of the external lateral panel and the bottom panel. Lamare discloses the claimed invention except for the specifics of the opening.

However, DeNola teaches a package comprising two box sections (30 and 32), each including an opening (62/64), wherein each opening has at least one locating tongue (66/60) attached to an internal panel at one end for the purpose of adding cushion to protect an article when its placed in the opening. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the openings of Lamare to include locating tongues as taught by DeNola in order to better protect the article by adding more cushioning.

Regarding claims 2, 3, 5-11 and 15, Lamare-DeNola discloses the package is made from one piece; the bottom panel is square; the locating tongues include at least one transverse scoring line (line between tabs) over their length; each box-section is formed in one piece with the bottom panel by a rectangular panel connected by a first scoring line (17) to the edge of the bottom panel, said rectangular panel including a second scoring line (fold line between 13 and 18) delimiting the external lateral panel, a

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third scoring line (fold line 20) delimiting the intermediate panel, a fourth scoring line (fold line between 11 and 19) delimiting the internal lateral panel, and said rectangular panel extending beyond the fourth scoring line by way of a fixing flap (19) fastened to the bottom panel so that the fourth scoring line is juxtaposed to the first scoring line; the fixing flap is glued to the bottom panel; the intermediate panel includes a longitudinal scoring line (line between panel 18 and fold line 20); the width of the external lateral panel is substantially equal to the width of the internal lateral panel; the width of the external lateral panel is substantially equal to the width of the internal lateral panel and said longitudinal scoring line is disposed substantially along the longitudinal median line of the intermediate panel; the means for holding the box-sections and the flaps in the raised position include means (gussets 27) associated with the flaps and with the box-sections to hold the box-sections in the raised position when the flaps are in the raised position and means (at fold line 28) for holding the flaps facing each other against the box-sections; the flaps are each attached to the adjacent longitudinal ends of the box-sections by two gussets (27).

Regarding claim 16, Lamare discloses a sheet material packaging blank characterized in that it comprises a bottom panel (7); two external lateral panels (11) connected by a scoring line (17) to two opposite edges of the bottom panel; two flaps (14) each connected by a scoring line (24) to a respective one of the other two edges opposite of the bottom panel; two intermediate panels (18) connected by a scoring line to each of the opposite edges of the bottom panel of the two external lateral panels; two internal lateral panels (11) each connected by a scoring line to a respective one of said

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intermediate panels at the edge thereof opposite the external lateral panel, each internal lateral panel being extended, in the direction away from the intermediate panel, by a fixing flap (19), the internal lateral panels further including a cut-out (15). Lamare discloses the claimed invention except for the specifics of the cut-out and the closure panel.

Regarding the specifics of the cut-out, DeNola teaches a package comprising two box sections (30 and 32), each including an opening (62/64), wherein each opening has at least one locating tongue (66/60) attached to an internal panel at one end for the purpose of adding cushion to protect an article when its placed in the opening. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cut-outs of Lamare to include locating tongues as taught by DeNola in order to better protect the article by adding more cushioning.

Regarding the closure panel, DeNola teaches a closure panel (46) for the purpose of closing the top opening of the package to better hold the article in place. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the package of Lamare with a closure panel as taught by DeNola in order to close the top opening of the package to better hold the article in place when the sleeve 5 is not in use.

Regarding claims 19-22, Lamare-DeNola discloses the width of the external lateral panel and the width of the internal lateral panel are substantially equal; the external lateral panels and the flaps are connected in pairs at their ends adjacent the bottom panel by a gusset; the widths of each of the flaps and of each of the external

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lateral panel are substantially equal; and the method of packaging and positioning a circular contour object whose diameter is substantially equal to the length of the square bottom panel.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamare (EP 0693428) in view of DeNola (US 5,529,187) as applied to claim 1 above, and further in view of Saiki et al. (US 5,829,587). As described above, Lamare-DeNola discloses the claimed invention except for the specific number of locating tongues. However, Saiki teaches a package comprising a box sections (30) including openings (39) with at least four locating tongues (43) for the purpose of securely holding the article within the opening. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the openings of Lamare-DeNola to include at least four locating tongues as taught by Saiki in order to more securely hold the article in place within the openings.

8. Claims 12-14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamare (EP 0693428) in view of DeNola (US 5,529,187) as applied to claims 1 and 16 above, and further in view of Carpenter (US 2,846,132). As described above, Lamare-DeNola discloses the claimed invention except for the specifics of the closure panel. However, Carpenter teaches a package comprising a closure panel (12) including a scoring line (line between 12 and 14) adjacent to a fold-down panel (14) adapted to be superimposed on the front wall of the bottom section, and attachment means (19 and 21) projecting from the edges of the closure panel which cooperate with notches (17 and 20) in the side walls of the bottom section for the



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purpose of securely holding the package in its closed position. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Lamare-DeNola with a fold down panel, attachment means and notches as taught by Carpenter in order to more securely hold the package closed.

9. Claims 1-7, 9, 11, 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saiki et al. (US 5,829,587). Saiki discloses packaging (10) for protecting and locating a circular contour object such as an eyeglass lens, the packaging including a bottom panel (11); two box-sections (30/20) each including an external lateral panel (31/21) and an internal lateral panel (33/23) that includes an opening (39/29) for at least partial insertion of the object, each box-section being attached by an articulation (fold line between 11/31 and fold line between 11/21) to the bottom panel along a respective one of two opposite edges, each box-section being adapted to assume a folded down position (See Fig. 2) in which the external lateral panel is in line with the bottom panel and a raised position (See Fig. 1) in which the external lateral panel upstands relative to the bottom panel; two flaps (panels 35/36) each attached by an articulation (fold lines) to the bottom panel along a respective one of two opposite edges adjacent the box-sections, each flap being adapted to assume a folded down position in which it is in line with the bottom panel and a raised position in which the flap upstands relative to the bottom panel, against the longitudinal ends of the box-sections; and means for maintaining the box-sections and the flaps in the raised position (37/38); characterized in that, for each box-section, said external lateral panel

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has a first end connected by an articulation (fold line between 11/31 and fold line between 11/21) to the bottom panel, a second end connected by an articulation (fold line between 31/32 and 21/22) to a first end of an intermediate panel (32/22), the latter also including a second end connected by an articulation (fold line between 32/33 and 22/23) to a first end of said internal lateral panel, the latter also including a second end connected by an articulation (fold line between 33/34 and 23/24) to the bottom panel along the articulation between the first end of the external lateral panel and the bottom panel, in that at least one locating tongue (43) is disposed in the opening (39) of one box-section and attached to the internal lateral panel by only an end opposite the bottom panel. Saiki discloses the claimed invention except for the opening (29) of the second box-section having locating tongues. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening (29) of Saiki with locating tongues (43) as disclosed in the bottom openings (39) in order to better hold the top of the article in place. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 2, Saiki discloses the package is made in one piece.

Regarding claim 3, Saiki discloses the claimed invention except for the specific shape of the bottom panel. To modify the shape of the bottom panel to be square as claimed would entail a mere change in shape of the bottom panel in order to hold articles of a desired size and yield only predictable results. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize

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that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." KSR Int'l v. Teleflex Inc., 127 S.Ct. 1740, 82 USPQ2d 1396 (2007). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In re Dailey et al., 149 USPQ 47.

Regarding claims 4-7, 9, 11, 15 and 22, Saiki discloses four locating tongues (43) are disposed in each opening and are independent of the others and attached to the bottom panel at one end (attached through another panel); the locating tongues include at least one transverse scoring line (line between tabs) over their length; each box-section is formed in one piece with the bottom panel by a rectangular panel connected by a first scoring line to the edge of the bottom panel, said rectangular panel including a second scoring line delimiting the external lateral panel, a third scoring line delimiting the intermediate panel, a fourth scoring line delimiting the internal lateral panel, and said rectangular panel extending beyond the fourth scoring line by way of a fixing flap (34/24) fastened to the bottom panel so that the fourth scoring line is juxtaposed to the first scoring line; the fixing flap is glued to the bottom panel; the width of the external lateral panel is substantially equal to the width of the internal lateral panel; the means for holding the box-sections and the flaps in the raised position include means (37/38) associated with the flaps and with the box-sections to hold the box-sections in the raised position when the flaps are in the raised position and means (glue) for holding the flaps facing each other against the box-sections; the flaps are each attached to the adjacent longitudinal ends of the box-sections by two gussets (37/38 can be considered

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gussets when attached); and the obvious method of packaging and positioning an object of any shape, including circular contour object whose diameter is substantially equal to the length of the square bottom panel.

10. Claims 12-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saiki et al. (US 5,829,587) in view of Carpenter (US 2,846,132). Saiki discloses a sheet material packaging blank characterized in that it comprises a bottom panel; two external lateral panels connected by a scoring line to two opposite edges of the bottom panel; two flaps (14) each connected by a scoring line to a respective one of the other two edges opposite of the bottom panel; two intermediate panels connected by a scoring line to each of the opposite edges of the bottom panel of the two external lateral panels; two internal lateral panels each connected by a scoring line to a respective one of said intermediate panels at the edge thereof opposite the external lateral panel, each internal lateral panel being extended, in the direction away from the intermediate panel, by a fixing flap, the internal lateral panels further including a cut-out (39) . Saiki discloses the claimed invention except for the cut-out (29) of the second box-section having locating tongues and the closure panel.

Regarding the locating tongues, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening (29) of Saiki with locating tongues (43) as disclosed in the bottom openings (39) in order to better hold the top of the article in place. It has been held that mere duplication of the

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essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding the closure panel, Carpenter teaches a package comprising a closure panel (12) including a scoring line (line between 12 and 14) adjacent to a fold-down panel (14) adapted to be superimposed on the front wall of the bottom section, and attachment means/tongues (19 and 21) projecting from the edges of the closure panel which cooperate with notches (17 and 20) in the side walls of the bottom section for the purpose of securely holding the package in its closed position. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Saiki with a closure panel with a fold down panel and attachment means/tongues, and notches to the sidewalls as taught by Carpenter in order to securely hold the package closed when sleeve (2) is removed.

Regarding claims 19-21, Saiki-Carpenter discloses the width of the external lateral panel and the width of the internal lateral panel are substantially equal; the external lateral panels and the flaps are connected in pairs at their ends adjacent the bottom panel by a gusset; and the widths of each of the flaps and of each of the external lateral panels are substantially equal.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 form.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:30am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. R./  
Examiner, Art Unit 3728

/Mickey Yu/  
Supervisory Patent Examiner, Art  
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